

*REMARKS/ARGUMENTS*

*Request for Interview*

In accordance with M.P.E.P. § 706.07(b), the Applicant respectfully requests a personal interview with the Examiner prior to the issuance of any further Office Actions.

The amendments set out above and the following remarks are responsive to the points raised by the Office Action dated February 26, 2009. In view of the amendments set out above and the following remarks, reconsideration is respectfully requested.

*The Pending Claims*

Claim 17 is added, so that claims 1-17 are pending. No new matter has been added, and support for the amended claim language may be found within the original specification, claims, and drawings. Support for new claim 17 may be found in the specification at, e.g., original claim 1, paragraph [0012] and paragraph [0027].

*The Office Action*

Claims 1-4, 6, 10-12 and 16 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent Application Publication No. 2004/0136774 to O'Boyle (hereinafter, "O'Boyle") in view of U.S. Patent Application Publication No. 2003/0030269 to Hernandez (hereinafter, "Hernandez") and further in view of U.S. Patent No. 4,932,520 to Ciarcia et al. (hereinafter, "Ciarcia").

Claims 5 and 15 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 5,651,628 to Bankes et al. (hereinafter, "Bankes").

Claim 7 was rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2002/0089166 to Schwartz (hereinafter, "Schwartz").

Claims 8-9 and 13-14 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2004/0253046 to Africa (hereinafter, "Africa").

Each of these rejections is separately and respectfully traversed.

For an obviousness rejection to be maintained, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art and must provide an appropriate supporting rationale for the proposed modification (*KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007); (MPEP § 2141). In the case at hand, the cited combination of references, O'Boyle, Hernandez, and Ciarcia, fails to teach or suggest each and every element of the claim, and the Office Action fails to explain why it would have been obvious to one of ordinary skill in the art to modify O'Boyle to have separation sheets that are inseparable from a binder that joins front and back leaves together, as claimed in claims 1 and 17.

O'Boyle discloses a notebook (10) comprising front (17) and back (18) covers, a spiral binding (11) joining front and back covers together, and sheets 16 connected to the binder between the front and back covers. The Office Action correctly acknowledges that O'Boyle fails to disclose a notebook comprising i) detachable sheets and ii) separation sheets.

Hernandez discloses pages separable via perforations (par. [0054]).

Ciarcia discloses a plurality of clear plastic envelopes (40) attached to one another to a binder (42) to which a backing securement flap (46) is attached (Figure 3). The securement flap (46) is inserted into the slot (26) on the inside face (24) of the right hand cover (14), parallel to the edge (15).

Ciarcia fails to disclose separation sheets with tabs inseparably connected to a binder that joins the front and back leaves together, as claimed in claims 1 and 17. In Ciarcia, the envelopes are fastened into the wallet by removably inserting the securement flap attached to the envelopes (40) into a slot (26) on the inside face of the cover. The slot (26) is clearly distinguishable from a binder that joins the front and back leaves together, and the envelopes are removably inserted. Thus, it cannot be said that the envelopes (40) of Ciarcia are inseparably connected to a binder that joins the front and back leaves together, as claimed in

claims 1 and 17. Because the plastic envelopes (40) of Ciarcia are removable, and are not inseparately connected to a binder that joins front and back leaves together, Ciarcia does not cure the deficiencies of O'Boyle. Thus, combining the teachings of Ciarcia with the teachings of O'Boyle would not result in a filing notebook including inner separation sheets inseparably connected to a binder that joins the front and back leaves together, as claimed in claims 1 and 17. Nor has the Office Action explained why providing separation sheets that are inseparable from a binder that joins front and back leaves together would be obvious to one of ordinary skill in the art. Accordingly, the combination of O'Boyle, Hernandez, and Ciarcia does not render the subject matter of claims 1 and 17 obvious.

In addition, one of ordinary skill in the art would be discouraged from combining the teachings of Ciarcia with O'Boyle. Ciarcia includes a plurality of envelopes 40 with the tabs 52, open top edges 48 to permit backing sheets 50 to be slipped therein, and corner pockets 62. One of ordinary skill in the art would be discouraged from including the envelopes of Ciarcia in a notebook because the envelopes of Ciarcia have a complicated structure that would increase the manufacturing costs for a notebook.

In contrast to the complicated structure provided by Ciarcia, the claimed filing notebook has inner separation sheets with tabs for filing notebook pages separated from the binder in compartments provided by the inner separation sheets that are inseparably connected to the binder. The notebook pages are, advantageously, simply inserted between adjacent inner separation sheets of the notebook. Accordingly, the obviousness rejection cannot be maintained.

Moreover, although Hernandez discloses pages separable via perforations (par. [0054]), Hernandez further indicates that the detached pages, on which expense summaries are listed, are submitted to the accounting department or the department that processes expense reports (paragraph [0071]). Accordingly, the detached pages of Hernandez are not to be inserted within the notebook 10 of Hernandez. Thus, one of ordinary skill in the art looking for a way to store detached sheets within a notebook would not look to Hernandez. Thus, the obviousness rejection cannot be maintained.

New claim 17 is also patentable for the reasons set forth above. New claim 17 further recites that the inner separation sheets are located between the notebook pages of the

notebook and one of the front and back leaves, and that the filing notebook comprises at least one closing means including an elastic band fastened to one of the front and back leaves by rivets sliding relative to the leaf via eyelets that is adapted to be pulled over the inner separation sheets.

These additional features of claim 17 provide the important advantage that a user can write on the notebook pages while keeping detached pages inserted between the inner separation sheets located between the notebook pages and one of the front and back leaves of the notebook using the claimed closing means. Therefore, the notebook can, advantageously, be used vertically without losing the detached pages.

Africa discloses a closure mechanism including a loop or strap of expandable or elastic material 68 fixedly coupled to the rear or front cover, which can be stretched and looped around the anchor component on the opposite cover (Africa, pars. [0017]-[0018]). Africa fails to teach a notebook having inner separation sheets with tabs located between notebook pages and one of the front and back covers, as claimed. In contrast, the elastic material of Africa cooperates with the front cover 12 and the rear cover 14 to maintain them in their closed position. Therefore, Africa does not teach an elastic band that is adapted to be pulled over any inner separation sheets, as claimed. Nor does the Office Action explain why it would have been obvious to one of ordinary skill in the art to include closing means to be pulled over the inner separation sheets located between the notebook pages of the notebook and one of the front and back leaves, as claimed. Accordingly, claim 17 is patentable over the cited references.

For the reasons set forth above, the present invention would not have been obvious to one of ordinary skill in the art at the relevant time in view of the combined disclosures of O'Boyle, Hernandez, and Ciarcia. Accordingly, the obviousness rejection should be withdrawn.

The dependent claims are also patentable because they depend from, and include the limitations of, independent claim 1.

*Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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